

### **REMARKS**

Applicants have timely submitted a Request for Continued Examination and this response to the Examiner's Final Office Action of February 10, 2004. Applicants also submit herewith an Interview Request Form. Applicants respectfully request the courtesy of a personal interview with the Examiner prior to the next action on the merits. Although Applicants have requested an interview in September, with a specific date to be arranged at a later date, Applicants are amenable to any later mutually acceptable date.

The Final Office Action dated February 10, 2004 has been carefully reviewed and the following remarks are made in response thereto. In view of the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

#### **I. Summary of the Office Action**

1. Claims 1-23 are currently pending.
2. Claims 1-3, 14-20, and 23 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Angles *et al.*
3. Claims 4-13, 21 and 22 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Angles *et al.* and further in view of Usui.
4. No claims were allowed.

#### **II. Response to the Office Action**

1. **Rejection of the claims under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Angles *et al.***

Claims 1-3, 14-20, and 23 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Angles *et al.* Applicants respectfully traverse this rejection.

Respectfully, the Examiner fails to establish a *prima facie* case of obviousness for two reasons. First, the cited references, Bessette and Angles *et al.*, neither teach nor suggest specific elements of the claimed methods or systems. Second, the Examiner fails

to establish a suggestion or motivation to modify or combine the cited references by either: a) completely failing to identify reasons why a skilled artisan would modify or combine the teachings of the cited references to obtain the claimed invention; b) failing to consider the cited references as a whole; and c) taking official notice.

**A. Each and every element of the claimed invention is not taught or suggested.**

- **“...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer...”**

The claimed methods of claims 1-3 and 14-15 comprise the step of “...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer...” The Examiner concedes that Bessette “does not teach establishing a telecommunication link” between the library system computer—designated “server 300” in Bessette—and “the content provider computer” (designated “NDSMR database” in Bessette). (*See*, Final Office Action, paragraph 4, page 3, lines 14-18). Angles *et al.* also does not teach transmission of information from a library system computer to a content provider computer. In Figures 10 and 11 on which the Examiner relies, Angles *et al.* teaches a telecommunication link between an advertisement provider computer, a consumer computer and a content provider computer. The Examiner alleges that the advertisement provider computer is equivalent to the recited “library system computer” and the consumer computer is equivalent to the recited “user computer”. (*See*, Final Office Action, sentence spanning page 3 and 4). Importantly, the advertisement provider computer of Angles *et al.* (i.e. library system computer) **only receives information** from a content provider computer and **only transmits information** to a consumer computer (i.e. user computer). Thus, the cited references fail to teach the recited step of “...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer...”

Applicants therefore respectfully request that this rejection of claims 1-3 and 14-15 be withdrawn, and that the pending claims be allowed.

- “...customizing a user interface provided by the interactive library system to the user computer based on type of information desired by the user.”

The method of claim 2 comprises the step of “customizing a user interface provided by the interactive library system to the user computer based on type of information desired by the user.” The system of claim 19 comprises “customized user interface data”. The Examiner references a portion of Bessette (col. 7, lines 52-56) that states that a physician, after logging onto the server, may use an identifier to retrieve patient information. The referenced portion of Bessette does not teach “customizing a user interface provided by the interactive library system.” Instead, Bessette teaches accessing patient information stored on the NDSMR database. Bessette does not suggest that different users may alter or customize the interface, that the workstation provides interfaces specific to different users, or that the system could create and/or store “customized user interface data”. Thus, neither Bessette nor Angles *et al.* teach or suggest a method comprising a step of “customizing a user interface” or a system comprising “customized user interface data”.

Applicants therefore respectfully request that this rejection of claim 2 be withdrawn, and that the pending claims be allowed.

- “...at least one content provider requiring payment for information access...”

The claimed methods (claims 1-3, 14 and 15) or systems (claims 16-20 and 23) comprise “at least one user computer and computer of at least one content provider requiring payment for information access...” Neither Bessette nor Angles *et al.* teach or suggest a system or method that includes a “content provider requiring payment for information access.” First, the Examiner has equated the “content provider” referenced in claim 1 with the NDSMR database of Bessette. The NDSMR, however, is a database of Network Distributed Shared Medical Records that is a component of a network system for the storage of medical records that does not require payment for information access. Importantly, Bessette does not teach that the NDSMR requires payment for information access or even that paid access is a contemplated option. In the Final Office Action of February 10, 2004 (see paragraph 3), the Examiner apparently concedes this fact and

relies instead on the statement that “charging for access to the content is a very common practice well known in the art.”

Applicants therefore respectfully request that this rejection of claims 1-3, 14-20 and 23 be withdrawn, and that the pending claims be allowed.

- **“...notifying, by the library system computer, the user computer that said result of said search request is ready for review by the user...”**

The method of claims 14 and 15 comprise the step of “notifying, by the library system computer, the user computer that said result of said search request is ready for review by the user.” The Examiner does not allege that Bessette and Angles *et al.* teach this element of claims 14 and 15. (*See*, Final Office Action, paragraph 14). Instead, the Examiner improperly relies on official notice that “it is well known in the art to notify the user upon receiving the results of a search request...” The Examiner, however, fails to provide either a reference or reasoning sufficient to support a statement that “...notifying, by the library system computer...” was well known in the art.

Applicants therefore respectfully request that this rejection of claims 14-15 be withdrawn, and that the pending claims be allowed.

- **“...a second storage unit electrically coupled to said library system computer to store user identifications and corresponding passwords...”**

The system of claim 16 comprises “a second storage unit electrically coupled to said library system computer to store user identifications and corresponding passwords.” The Examiner alleges that the “validation table which maps all the registered user IDs to the corresponding passwords (see Besset [sic], column 10, lines 6-9 and lines 60-67)” satisfies this claim element. (*See*, Final Office Action, paragraph 12). The Examiner fails to explain the apparent dissimilarities between the “validation table” of Bessette and the “second storage unit” of claim 16. The Examiner also fails to distinguish between a software module and a storage unit, and between the “first storage unit” and the validation table of Bessette. Notably, according to claim 16, the comparison of user identification and passwords received from the user computer are compared using a

program “stored in said first storage unit”. Consequently, the Applicants respectfully disagree that Bessette teaches this element of claim 16.

Applicants therefore respectfully request that this rejection of claims 16-23 be withdrawn, and that the pending claims be allowed.

- **“...a third storage unit electrically coupled to said library system computer to store user identifications and corresponding passwords...”**

The system of claim 18 comprises “a third storage unit electrically coupled to said library system computer to store user-specific data.” The Examiner does not mention this claim element.

Applicants therefore respectfully request that this rejection of claims 18-23 be withdrawn, and that the pending claims be allowed.

- **“user-specific data” and “user account data”**

The systems of claims 18-20 and 23 comprise “a third storage unit electrically coupled to said library computer to store user-specific data”, generally, and user account data, specifically. The Examiner makes no mention of “user specific data”. The Examiner alleges that the “consumer member code” taught by Angles *et al.* in Figure 10 (22) is equivalent to “user account data.” The Examiner, however, provides no basis for this alleged equivalence. Importantly, the “consumer member code” taught by Angles *et al.* is identified as “22” and appears between the user computer and the content provider computer on Figure 10 and is not stored on a third storage unit electrically coupled to the advertisement provider computer (i.e. library system computer, for purposes of this argument) as recited by claim 18. Consequently, the Applicants respectfully disagree that Angles *et al.* teach this element of claims 18-23.

Applicants therefore respectfully request that this rejection of claims 18-23 be withdrawn, and that the pending claims be allowed.

**B. The Examiner’s reasoning constitutes improper hindsight reconstruction.**

With respect to claims 1-2, 14 and 15, the Examiner concedes that Bessette “does not teach establishing a telecommunication link” between the library system computer—

designated “server 300” in Bessette—and “the content provider computer” (designated “NDSMR database” in Bessette). (*See*, Final Office Action, paragraph 4, page 3, lines 14-18). The Examiner instead relies on Angles *et al.* when he concludes that “it would have been obvious to one of ordinary skill in the art to receive by the server of Besset [sic] an input from the user and establish the telecommunication link with the content provider computer as taught in Angles.” Applicants respectfully submit that there is no motivation to combine the teachings of Bessette and Angles *et al.* to obtain the claimed invention and the Examiner’s reasoning represents improper hindsight reconstruction that is based on the Applicants’ disclosure.

In Figures 10 and 11 on which the Examiner relies, Angles *et al.* teaches a telecommunication link between an advertisement provider computer, a consumer computer and a content provider computer. The Examiner alleges that the advertisement provider computer is equivalent to the recited “library system computer” and the consumer computer is equivalent to the recited “user computer”. (*See*, Final Office Action, sentence spanning page 3 and 4). Importantly, the advertisement provider computer of Angles *et al.* (i.e. library system computer) **only receives information** from a content provider computer and **only transmits information** to a consumer computer (i.e. user computer). Thus, combining the **one-way** telecommunication link between the content provider computer and advertisement provider computer of Angles *et al.* with the server and NDSMR database of Bessette would not produce the invention of claim 1, because the library system computer would be unable to **transmit** information to the content provider computer through the **one-way** telecommunication link of Angles *et al.* Similarly, combining the teachings of Bessette and Angles *et al.* would not produced the system of claim 16, because the library system computer of claim 16 would be unable to “communicate with the content provider computer to transmit type of information desired by the user as a search request” through the **one-way** telecommunication link of Angles *et al.*

The Examiner does not consider the cited references as a whole. In determining the differences between the prior art and the claims at issue, the Examiner must consider both the invention and the references as a whole. MPEP §§ 2111- 2116.01; 2141.02.

When determining the differences between the prior art and the claims, the operative question is not whether the differences themselves (a telecommunication link) would have been obvious, but whether the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Here the Examiner generalizes the teaching of the one-way telecommunication link of *Angles et al.* to simply a “telecommunication link” for the purpose of producing the claimed invention. This generalization of *Angles et al.* focuses on the obviousness of the difference between the cited references and the claimed invention—not the obviousness or nonobviousness of the invention as a whole. This is impermissible hindsight reconstruction. (*See, In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143 and 2143.03).

Applicants therefore respectfully request that this rejection of claims 1-3, 14 and 15 be withdrawn, and that the pending claims be allowed.

**C. Improper reliance on knowledge in the art.**

With respect to claims 1-3, 14 and 15, the Examiner takes official notice of the state of the art and states “that charging for access to the content is a very common practice well known in the art.” Applicants respectfully disagree.

Under only very limited circumstances may an examiner take official notice of a fact not in the record or rely on “common knowledge” in the art to support a rejection. Official notice without documentary evidence to support an examiner’s conclusion should be taken only on the rare occasion when the noticed fact is capable of instant and unquestionable demonstration as being well known. (*See*, MPEP § 2144.03; *see also, In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970)). That is not the case here.

The methods and systems of the claimed invention require “payment for information access”, and generating an account statement based on the time or the number of search requests determined by the library system computer. Broad notice “that charging for access to the content is a very common practice well known in the art” does not take into account the specific methods of charging recited by the claims. Thus, the noticed fact is insufficient to support the Examiner’s rejection of the claims and the

specific methods of fee charging recited by the claims are not the types of facts that are capable of instant and unquestionable demonstration as being well known.

Applicants therefore respectfully request that this rejection of claims 1-3, 14 and 15 be withdrawn, and that the pending claims be allowed.

2. **Rejection of the claims under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Angles et al. and further in view of Usui.**

Claims 4-13, 21 and 22 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Angles et al. and further in view of Usui. Applicants respectfully traverse this rejection.

Respectfully, the Examiner fails to establish a *prima facie* case of obviousness for two reasons. First, the cited references, Bessette, Angles *et al.*, and Usui neither teach nor suggest the claimed methods or systems. Specifically, these references fail to teach or suggest specific elements of the claimed invention. Second, the Examiner fails to establish a suggestion or motivation to modify or combine the cited references by either: a) completely failing to identify reasons why a skilled artisan would modify or combine the teachings of the cited references to obtain the claimed invention; b) failing to consider the cited references as a whole; and c) improperly relying on common knowledge in the art or improperly taking official notice.

A. **Each and every element of the claimed invention is not taught or suggested.**

- **“...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer...”**

The claimed methods of claims 4-13 comprise the step of “...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer...” The Examiner concedes that Bessette “does not teach establishing a telecommunication link” between the library system computer—designated “server 300” in Bessette—and “the content provider computer” (designated “NDSMR database” in Bessette). (*See*, Final Office Action, paragraph 4, page 3, lines 14-18). Angles *et al.* also does not teach transmission of information from a library system computer to a content provider computer. In Figures 10 and 11 on which the



Examiner relies, *Angles et al.* teaches a telecommunication link between an advertisement provider computer, a consumer computer and a content provider computer. The Examiner alleges that the advertisement provider computer is equivalent to the recited “library system computer” and the consumer computer is equivalent to the recited “user computer”. (*See*, Final Office Action, sentence spanning page 3 and 4). Importantly, the advertisement provider computer of *Angles et al.* (i.e. library system computer) **only receives information** from a content provider computer and **only transmits information** to a consumer computer (i.e. user computer). Thus, the cited references fail to teach the recited step of “**...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer...**”

Applicants therefore respectfully request that this rejection of claims 4-13 be withdrawn, and that the pending claims be allowed.

- **“...at least one content provider requiring payment for information access...”**

The claimed methods (claims 4-13) or systems (claims 21 and 22) comprise “at least one user computer and computer of at least one **content provider requiring payment for information access...**” Neither Bessette, *Angles et al.*, nor Usui teach or suggest a system or method that includes a “content provider requiring payment for information access.” First, the Examiner has equated the “content provider” referenced in claim 1 with the NDSMR database of Bessette. The NDSMR, however, is a database of Network Distributed Shared Medical Records that is a component of a network system for the storage of medical records that does not require payment for information access. Importantly, Bessette does not **teach** that the NDSMR requires payment for information access or even that paid access is a contemplated option. In the Final Office Action of February 10, 2004 (see paragraph 3), the Examiner apparently concedes this fact and relies instead on the statement that “charging for access to the content is a very common practice well known in the art.”

Applicants therefore respectfully request that this rejection of claims 4-13, 21 and 22 be withdrawn, and that the pending claims be allowed.

- **“...determining, by the library system computer, time amount of access to the interactive library system by the user computer...”**

The method of claim 4 comprises the step of “determining, by the library system computer, time amount of access to the interactive library system by the user computer” and claim 5 comprises the step of “generating an account statement” based on the “time amount of access to the interactive library system”. Neither Bessette nor Angles *et al.* teach fee-charging systems for “payment for information access”. Usui does not teach a fee-charging method that utilizes a “library system computer”. Hence, the cited references fail to teach or suggest payment for “information access” and determination by a library system computer of each user computer’s access time to “the interactive library system”.

Applicants therefore respectfully request that this rejection of claims 4 and 5 be withdrawn, and that the pending claims be allowed.

- **“...determining, by the library system computer, time amount of access by the user computer to each content provider...”**

The method of claim 6 comprises the step of “determining, by the library system computer, time amount of access by the user computer to each content provider” and claim 7 comprises the step of “generating an account statement” based on the “time amount of access”. Neither Bessette nor Angles *et al.* teach fee-charging systems for “payment for information access”. Usui does not teach a fee-charging method that utilizes a “library system computer”. Hence, the cited references fail to teach or suggest payment for “information access” and determination by a library system computer of each user computer’s access time to each content provider.

Applicants therefore respectfully request that this rejection of claims 6 and 7 be withdrawn, and that the pending claims be allowed.

- “...determining, by the library system computer, time amount of access by the user computer via the library system computer to each content provider...”

The method of claim 8 comprises the step of “determining, by the library system computer, time amount of access by the user computer via the library system computer to each content provider” and claim 9 comprises the step of “generating an account statement” based on the “time amount of access”. Neither Bessette nor Angles *et al.* teach fee-charging systems for “payment for information access”. Usui does not teach a fee-charging method that utilizes a “library system computer”. Hence, the cited references fail to teach or suggest payment for “information access” and determination by a library system computer of each user computer’s access time to each content provider via the library system computer.

Applicants therefore respectfully request that this rejection of claims 8 and 9 be withdrawn, and that the pending claims be allowed.

- “...accessing, by the content providers accessed by the user computer through the library system, preselected user information stored in the library system...”

The method of claim 12 comprises the steps of “accessing, by the content providers accessed by the user computer through the library system, preselected user information stored in the library system”. None of the cited references teach or suggest access of user information stored in the library system by specific contact providers.

Applicants therefore respectfully request that this rejection of claim 12 be withdrawn, and that the pending claims be allowed.

- “**user-specific data” and “user account data”**

The systems of claims 21 and 22 comprise “a third storage unit electrically coupled to said library computer” to store “user-specific data”, generally, and “user account data”, specifically. The Examiner does not mention “user specific data”. The Examiner alleges that a “consumer member code” taught by Angles *et al.* in Figure 10 (22) is equivalent to “user account data.” The Examiner, however, provides no basis for this alleged equivalence. Importantly, the “consumer member code” taught by Angles *et*

*al.* is identified as “22” and appears between the user computer on Figure 10 and the content provider computer and is not stored on a third storage unit electrically coupled to the advertisement provider computer (i.e. library system computer, for purposes of this argument) as recited by claim 18. Consequently, the Applicants respectfully disagree that *Angles et al.* teach this element of claims 18-23.

Applicants therefore respectfully request that this rejection of claims 21 and 22 be withdrawn, and that the pending claims be allowed.

**B. The Examiner’s reasoning constitutes improper hindsight reconstruction.**

Claims 4-13, 21 and 22 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over *Bessette* in view of *Angles et al.* and further in view of *Usui*. Applicants respectfully traverse this rejection.

The deficiencies of *Bessette* and *Angles et al.* are detailed in the previous section. *Usui*, does not remedy the deficiencies of *Bessette* and *Angles et al.* Consequently the Examiner fails to establish a case of *prima facie* obviousness of claims 4-13, 21 and 22.

*Usui* does not teach a “content provider requiring payment for information access.” In particular, *Usui* teaches a “timer-based fee-charging system for Internet services” for the purpose of eliminating the inconvenience of contracting with an Internet provider a providing “access to Internet connection services through an easy access and payment method.” (*See, Usui*, abstract). Both the purpose and the nature of the system disclosed by *Usui* is to provide a fee-charging mechanism for “access to Internet connection services”. *Usui* does not teach or suggest payment for “information access.”

The fee-charging system of *Usui* is limited to a timer-based system. The Examiner, however, apparently applies the teachings of *Usui* to support the rejection of claims 10 and 11, which require the “library system computer” to determine “the number of search requests transmitted to the content providers for the user computer” and generate “an account statement” based on the number of search requests. Neither *Bessette*, *Angles et al.*, nor *Usui* teach or suggest a search-based system for fee charging.

Applicants therefore respectfully request that this rejection of claims 4-13, 21 and 22 be withdrawn, and that the pending claims be allowed.

**C. Improper reliance on knowledge in the art.**

With respect to claims 4-13, the Examiner takes official notice of the state of the art and states “that charging for access to the content is a very common practice well known in the art.” Applicants respectfully disagree.

Under only very limited circumstances may an examiner take official notice of a fact not in the record or rely on “common knowledge” in the art to support a rejection. Official notice without documentary evidence to support an examiner’s conclusion should be taken only on the rare occasion when the noticed fact is capable of instant and unquestionable demonstration as being well known. (*See*, MPEP § 2144.03; *see also*, *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970)). This is not the case here.

The methods and systems of the claimed invention require “payment for information access”, and generating an account statement based on the time or the number of search requests determined by the library system computer. Broad notice “that charging for access to the content is a very common practice well known in the art” does not take into account the specific methods of charging recited by the claims. Thus, the noticed fact is insufficient to support the Examiner’s rejection of the claims and the specific methods of fee charging recited by the claims are not the types of facts that are capable of instant and unquestionable demonstration as being well known.

Applicants therefore respectfully request that this rejection of claims 4-13 be withdrawn, and that the pending claims be allowed.

**III. Conclusion**

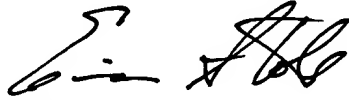
Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 02012.4101. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F. R. § 1.136(a)(3).

If the Examiner finds that a telephone conference would further prosecution of this application, the Examiner is invited to contact the undersigned at 202-835-7553.

Respectfully submitted,

**MILBANK, TWEED, HADLEY & MCCLOY LLP**



Dated: August 10, 2004

Einar Stole  
Reg. No. 47,272

**Customer No. 000038647**  
**Milbank, Tweed, Hadley & McCloy LLP**  
International Square Building  
1825 Eye Street, N.W., Suite 1100  
Washington, D.C. 20006  
Telephone: (202) 835-7526  
Facsimile: (202) 835-7586